

NOTICE OF MOTION

TO ALL PARTIES AND THEIR ATTORNEYS:

PLEASE TAKE NOTICE that on April 28, 2022 at 8:00 a.m., or as soon thereafter as may be heard before the Honorable Judge William Alsup in Courtroom 12 on the 19th Floor of the United States District Court for the Northern District of California, San Francisco Courthouse, 450 Golden Gate Avenue, San Francisco, CA 94102, Defendant Sonos, Inc (“Sonos”) will, and hereby does, move this Court for an order granting Sonos leave to file an Amended Answer to Google LLC’s Second Amended Complaint and Sonos, Inc.’s Counterclaims (“Amended Answer and Counterclaims”). This motion is based on this Notice of Motion, the accompanying Memorandum of Points and Authorities, the Declaration of Cole B. Richter (“Richter Decl.”), and exhibits thereto, all documents in the Court’s file, and such other written or oral evidence and argument as may be presented at or before the time this motion is heard by the Court. The parties met-and-conferred on Thursday, March 10, 2022 and Friday, March 11, 2022. Google has indicated that it does not oppose this motion.

STATEMENT OF THE RELIEF REQUESTED

Pursuant to Rule 15(a)(1)(A) and/or Rule 15(a)(2) of the Federal Rules of Civil Procedure, Sonos requests that this Court grant Sonos leave to file an Amended Answer and Counterclaims.

MEMORANDUM OF POINTS AND AUTHORITIES

I. SUMMARY OF ARGUMENT

To the extent leave is required, Sonos respectfully seeks the Court’s leave to file an Amended Answer and Counterclaims (filed concurrently herewith in redline as Ex. 1 to the Declaration of Cole B. Richter in Support of Sonos’s Motion (“Richter Decl.”)) to include matter from Sonos’s infringement contentions – which were previously attached to the Answer and Counterclaims (Dkt. 135) as an exhibit – into the numbered paragraphs of the Counterclaims. Although this may seem like an unnecessary endeavor, Sonos is doing so out of an abundance of caution to obviate an objection by Google that certain of Sonos’s infringement theories are not properly part of the case because they were not repeated in the numbered paragraphs of Sonos’s Counterclaims.

1 This first Amended Answer and Counterclaims is being submitted within 21 days after the
 2 filing of Sonos's Answer and Counterclaims on February 18, 2022.¹ Thus, Sonos believes this
 3 amendment falls within the province of Rule 15(a)(1)(A) and no leave of Court is required.
 4 Fed.R.Civ.P. 15(a)(1)(A) ("*A party may amend its pleading once as a matter of course within []*
 5 *21 days after serving it . . .*").

6 Sonos acknowledges that that the Court's Case Management Order states that leave to
 7 amend pleadings must be sought by December 23, 2021. Dkt. 67 at ¶ 3. Sonos interprets this
 8 requirement as applying to situations where the Federal Rules state that the court's leave is
 9 required. *See Fed.R.Civ.P. 15(a)(2) ("In all other cases, a party may amend its pleading only*
 10 *with the opposing party's written consent or the court's leave. The court should freely give leave*
 11 *when justice so requires.").* However, out of an abundance of caution, Sonos respectfully submits
 12 this motion for leave to the extent the Court considers that leave is required in this scenario.

13 **II. FACTUAL BACKGROUND**

14 Sonos's infringement contentions have contained specific theories of infringement under §
 15 271(f) since before this case was transferred to this district. For instance, on **September 10,**
 16 **2021**, while the case was pending in the Western District of Texas, Sonos served final
 17 infringement contentions pursuant to the local rules in that district, setting forth, *inter alia*,
 18 theories of infringement under § 271(f)(1) and § 271(f)(2) for each asserted patent. After the case
 19 was transferred to this District, Sonos served infringement contentions on **October 21, 2021**,
 20 pursuant to this district's PLR 3-1. These infringement contentions set forth, *inter alia*, theories
 21 of infringement under § 271(f)(1) and § 271(f)(2) for each asserted patent.

22

23

24

25

26

27 ¹ Sonos attempted to file the present motion on Friday, March 11, 2022. However, the Court's
 ECF system experienced a technical failure and was not able to accept filings from approximately
 11 a.m. Pacific time and onwards on that day. Accordingly, pursuant to local rule 5-1(d)(5),
 Sonos is filing this motion on the next court day.

1 Google filed a Second Amended Complaint on February 4, 2022. Dkt. 125. Fourteen
 2 days later, on February 18, 2022, Sonos filed its Answer and Counterclaims. Dkt. 135. When
 3 Sonos filed its Answer and Counterclaims, Sonos did not copy its infringement contentions into
 4 the numbered paragraphs of the Counterclaims. Rather, for brevity's sake, Sonos's
 5 Counterclaims noted that Sonos had provided Google with infringement contentions over the
 6 course of the case and attached those contentions as an exhibit to the pleading.

7

8	21 83. In the course of this litigation, Sonos has served Google with infringement	
9	22 contentions detailing Google's infringement of the '615 Patent. <i>See</i> Ex. CH; Ex. CI.	

10

E.g., Dkt. 135, Counterclaims at ¶83 (*citing* Exhibit CH); Dkt. 137-8 (Ex. CH, Sonos's
 11 Infringement Contentions).

12

At no point during this case (or while the case was pending in Texas) did Google object to
 13 Sonos advancing theories of infringement under § 271(f) on grounds that Sonos's pleading did
 14 not set forth those same allegations. Nor did Google raise this ground as a basis for responding or
 15 objecting to any Sonos discovery request. Indeed, had Google raised such an objection in
 16 response to receiving Sonos's final infringement contentions in Texas on September 10, 2021 or
 17 in its response to any discovery request, Sonos could have responded to the objection by
 18 amending its operative complaint (prior to the deadline set forth by either this Court or the court
 19 in Texas.²

20

Not only did Google fail to raise any objection to Sonos's infringement theories under
 21 § 271(f), but Google proceeded with the case (for a time) as though the theories *are* properly part
 22 of the case (because they are). Indeed, Google has produced documents in this case that reflect
 23 worldwide financial information. Google initially objected to producing such information but
 24 acquiesced after an explanation that such information was relevant to Sonos's infringement
 25 theories under § 271(f). *See WesternGeco LLC v. ION Geophysical Corp.*, 138 S. Ct. 2129, 2137-

26

² The deadline for amending pleadings without a motion in that case was October 22, 2021. Amended Scheduling Order, *Sonos Inc. v. Google LLC*, No. 6:20-cv-00881-ADA, Dkt. 48 at 3 (W.D. Tex. February 11, 2021).

1 38 (2018); *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, No. 14-CV-03657-SI, 2018 WL
 2 6175982, at *2 (N.D. Cal. Nov. 26, 2018).

3 On the afternoon of March 9, 2022 (two days prior to this motion), Google took the
 4 position that Sonos's infringement theories under statutory subsection § 271(f) were not properly
 5 part of the case because the body of Sonos's February 18, 2022 counterclaim pleading (i.e., the
 6 numbered paragraphs) did not restate Sonos's infringement theories under § 271(f), even though
 7 such theories were set forth in Sonos's infringement contentions served months earlier and were
 8 attached to the pleading as Exhibit CH. As a result, Google has now objected to Sonos's request
 9 for a corporate deponent to testify concerning worldwide financial information.

10 In an effort to avoid burdening the Court with a motion to compel or a protective order on
 11 the issue, Sonos hopes to obviate Google's objection by amending its pleading as Rule 15 allows.
 12 The information Sonos seeks to add to the numbered paragraphs of the pleading is already
 13 included in the original pleading because it was cited to and contained within an exhibit attached
 14 to the pleading. *See Fed.R.Civ.P 10(c)* ("A copy of a written instrument that is an exhibit to a
 15 pleading is a part of the pleading for all purposes."); *Lagan Precision Co., Ltd. v. Genius Elec.*
Optical Co., Ltd., No. 13-cv-02502-WHO, 2013 WL 5934698, *4 (N.D. Cal. 2013) (relying on
 17 material contained within a letter referenced in the pleading in denying motion to dismiss indirect
 18 infringement claims for being insufficiently pled). Moreover, the information Sonos seeks to add
 19 to the numbered paragraphs has already been part of the case for over six months in Sonos's
 20 infringement contentions.

21 **III. GOOD CAUSE EXISTS**

22 Good causes exists for the Court's leave. Rule 15 states that Sonos may amend its
 23 pleading as a matter of course within 21 days of serving it. This motion is submitted within 21
 24 days of service of the original complaint. Thus, Sonos is in compliance with Rule 15.

25 To the extent leave is required, Rule 15 states that "[t]he court should freely give leave
 26 when justice so requires." Fed.R.Civ.P. 15(a)(2). Sonos submits that it would serve justice here
 27 to permit this amendment so as to obviate an objection Google has raised in the course of
 28 discovery.

1 Sonos has proceeded diligently upon learning of Google's objection. Indeed, Google
 2 raised its objection for the first time in the case just two days prior to this motion. Rather than
 3 burden the Court with a motion to compel or a protective order on whether Sonos can proceed
 4 with discovery on worldwide financial information and a theory at trial under § 271(f), Sonos
 5 short cuts all of this with the present request to amend the pleadings, while it is still permitted
 6 under Rule 15.

7 **IV. NO PREJUDICE EXISTS**

8 Google would not be prejudiced by this amendment.

9 **First**, Google has not answered the counterclaims and would thus suffer no prejudice from
 10 having already filed an Answer or Rule 12 motion. Indeed, this is why Rule 15(a)(1)(A) permits
 11 amendments as a matter of course within 21 days of filing the original pleading. Rule 15(a)(1)(B)
 12 also allows amendments as a matter of course within 21 days after a responsive pleading is filed.
 13 Google has not yet filed a response pleading to Sonos's counterclaims, so Sonos is well within
 14 this time period as well.

15 **Second**, the amendment literally copies into the pleading text from Sonos's infringement
 16 contentions that Google has had for over six months. Thus, nothing is being added to the
 17 pleading that Google is not already aware of.

18 **Third**, the text of the amendment is already technically part of the pleading pursuant to
 19 Rule 10(c) because this text is lifted from Sonos's infringement contentions, which were cited and
 20 attached to the pleading as Exhibit CH. Dkt. 135, Counterclaims at ¶83 (*citing* Exhibit CH); Dkt.
 21 137-8 (Ex. CH, Sonos's Infringement Contentions). Thus, the amendment does not introduce
 22 anything new.³ The amendment is entirely form over substance brought on by Google's meritless
 23 objection.

24
 25
 26

³ Sonos notes that Exhibit D to the original Answer and Counterclaims (copy of the '885 Patent)
 27 did not include a certificate of correction issued for the '885 Patent in 2021. For completeness,
 28 should this motion be granted, Sonos will attach a corrected Exhibit D to the Amended Answer
 and Counterclaims that includes this certificate of correction. This exhibit is attached hereto as
 Richter Decl., Ex. 2.

1 **V. CONCLUSION**

2 To the extent required, Sonos requests that this Court grant Sonos leave to file an
3 Amended Answer to Google LLC's Second Amended Complaint and Sonos, Inc.'s
4 Counterclaims.

5
6 Dated: March 14, 2022

By: /s/ Cole B. Richter

7 CLEMENT SETH ROBERTS
8 BAS DE BLANK
9 ALYSSA CARIDIS
10 EVAN D. BREWER

11 ORRICK, HERRINGTON & SUTCLIFFE LLP

12 SEAN M. SULLIVAN
13 COLE B. RICHTER

14 LEE SULLIVAN SHEA & SMITH LLP

15 *Attorneys for Defendant Sonos, Inc.*

16
17
18
19
20
21
22
23
24
25
26
27
28